

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM R. DUBRUL

Appeal No. 2003-1513
Application No. 09/326,412

ON BRIEF

Before OWENS, DELMENDO, and POTEATE, Administrative Patent Judges.

DELMENDO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 (2002) from the examiner's rejection of claims 19, 20, and 22, which are all the claims pending in the above-identified application.¹

¹ Following entry of a notice of appeal and appeal brief on Mar. 18, 2002 (papers 24 and 26), the examiner reopened prosecution in an Office action mailed on Aug. 19, 2002 (paper 27). In reply to this Office action, the appellant requested reinstatement of the appeal pursuant to 37 CFR § 1.193(b)(2)(ii)

The subject matter on appeal relates to a tissue expander.² According to the appellant (specification, page 2, lines 19-22), "[t]he improvement comprises configuring the injection site of the tissue expander so that it has a magnetically locatable component in it so that it is detectable from outside of the patient's body." Further details of this appealed subject matter are recited in representative claims 19 and 22 reproduced below:

19. A tissue expander of the type which is implantable beneath the skin of a patient comprising:
an expandable envelope having an anterior portion and a posterior portion and defining an inflatable interior therebetween;
said anterior portion being unreinforced;
a magnetically locatable percutaneous filling mechanism mounted to the anterior portion;
preventing means, along the posterior portion, for preventing the expandable envelope from folding over on itself during placement or implantation of the tissue expander into a patient; and
said preventing means being substantially coextensive with said posterior portion.

22. The tissue expander according to claim 19 wherein said preventing means comprises a posterior portion which is thicker than the anterior portion.

(1997). (Supplemental appeal brief filed Nov. 18, 2002, paper 28, p. 1.)

² The specification explains that "[t]issue expanders are a common tool used by general, plastic and reconstructive surgeons" and that "[t]hey allow the surgeon to create additional tissue for reconstructive or cosmetic surgery..." (Specification, p. 2, ll. 25-27.)

The examiner relies on the following prior art references as evidence of unpatentability:

Baker	5,104,409	Apr. 14, 1992
Boyd	5,146,933	Sep. 15, 1992

Claim 22 on appeal stands rejected under 35 U.S.C. § 112, ¶1, "as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." (Examiner's answer mailed Jan. 24, 2003, paper 29, page 3; Aug. 19, 2002 Office action, page 3.) Separately, claims 19, 20, and 22 on appeal stand rejected under 35 U.S.C. § 103(a) as unpatentable over Boyd in view of Baker. (Id. at pages 4-5.)

We reverse the rejection under 35 U.S.C. § 112, ¶1. We affirm, however, the rejection under 35 U.S.C. § 103(a) for the reasons well stated in the examiner's answer.³

Claim Interpretation

Prior to discussing the merits of the examiner's rejections, we must ascertain the meaning of the limitation

³ The appellants state: "Claims 19, 20 and 22 may be grouped together for purposes of a the [sic] rejection under 35 USC 103." (Supplemental appeal brief, p. 2.) We therefore

"preventing means [] for preventing the expandable envelope from folding over on itself during placement or implantation of the tissue expander into a patient" as recited in appealed claim 19. Because the "preventing means" is modified by function rather than structure, means-plus-function claim interpretation principles as provided under 35 U.S.C. § 112, ¶6 (2002) apply. Warner-Jenkinson Co. v. Hilton-Davis Chemical Co., 520 U.S. 17, 27, 41 USPQ2d 1865, 1870 (1997).

In describing the recited function for a preferred embodiment, the specification explains that the base of the expander (i.e., the posterior portion of the expander) is "thicker or reinforced" relative to the anterior portion of the expander. (Page 4, lines 5-18; page 11, lines 12-16.) Given this description, we construe "preventing means [] for preventing the expandable envelope from folding over on itself during placement or implantation of the tissue expander into a patient" to encompass, or read on, a base that is "thicker or reinforced" relative to an anterior portion of the expander.

35 U.S.C. § 112, ¶1

In the Aug. 19, 2002 Office action (page 3), the examiner held:

confine our discussion of the §103 rejection to claim 19. 37 CFR § 1.192(c) (7) (1995).

On page 4, lines 10 and 19 of the Applicant's specification, the tissue expander is described as having a "thicker portion," but it does not state what thicker encompasses. Claims in a pending application are to be given their broadest reasonable interpretation. In re Hyatt, 54 USPQ2d 1664 (Fed. Cir. 2000). Therefore, it is not clear if one material is made thicker at the posterior or are the claims to be interpreted as the applicant discloses (Fig. 1) with two different materials in the present application.

The appellant, on the other hand, argues that the base may be either thicker or reinforced and that claim 22 "is limited to the situation in which the posterior portion (base) is thicker than the anterior portion." (Supplemental appeal brief, page 4.)

In the answer, the examiner presents an additional argument as follows: "Claim 22 recites 'preventing means comprises a posterior portion which is thicker than the anterior portion,' but fails to mention where the support is for this limitation." (Answer, pages 4-5.)

We cannot agree with the examiner on this issue.

As an initial matter, it is important to emphasize that the examiner bears the initial burden of presenting a prima facie case of unpatentability, whether it be based on prior art or on any other ground. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). "Insofar as the written description requirement is concerned, that burden is discharged

by 'presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims.'" In re Alton, 76 F.3d 1168, 1175-76, 37 USPQ2d 1578, 1583-84 (Fed. Cir. 1996) (citing In re Wertheim, 541 F.2d 257, 263-64, 191 USPQ 90, 97 (CCPA 1976)). In this case, the examiner has not met the initial burden of presenting a prima facie case of unpatentability under 35 U.S.C. § 112, first paragraph, written description requirement.

To satisfy the written description requirement of 35 U.S.C. § 112, first paragraph, the disclosure of the application as originally filed must reasonably convey to those skilled in the relevant art that the applicant, as of the filing date of the original application, had possession of the claimed invention. Alton, 76 F.3d at 1172, 37 USPQ2d at 1581; In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). The applicant, however, does not have to describe exactly the subject matter claimed. Union Oil Co. of Cal. v. Atlantic Richfield Co., 208 F.3d 989, 997, 54 USPQ2d 1227, 1232, 1233 (Fed. Cir. 2000).

Contrary to the examiner's stated position (answer, pages 4-5), a claim does not have to point out where support may be found in the corresponding written description. Furthermore, as we discussed above, the present specification reasonably conveys

to one skilled in the relevant art that the appellant had possession of a preferred preventing means in which the base is "thicker or reinforced" relative to the anterior portion. Appealed claim 22 merely limits the "preventing means" to comprise a "posterior portion which is thicker than the anterior portion." Thus we see no basis for alleging that appealed claim 22 lacks adequate written description.

For these reasons, we cannot uphold the examiner's rejection on this ground.

35 U.S.C. § 103(a)

We are in complete agreement with the examiner's findings and conclusions, so we adopt them as our own.

The appellant argues: "Baker describes a mammary implant (not a tissue expander) and makes no mention of a tissue expander anywhere in the patent." (Supplemental appeal brief, page 3.) This argument lacks merit. Boyd, the principal prior art reference, teaches: "[T]here have been numerous attempts to provide volume-adjustable, anatomically-shaped mammary implants, including tissue-expander devices." (Column 2, lines 59-62; emphasis added.) Because a tissue expander is an anatomically shaped mammary implant, one of ordinary skill in the art would have found the requisite motivation or suggestion to combine the teachings of Boyd and Baker.

The appellant urges (supplemental appeal brief, page 3):

Accordingly, the art lacks even a suggestion that there was a recognition of a need to provide folding over preventing means. Also, there is nothing in these two patents that discloses or suggests that it would have been an advantage to prevent such folding over. Lacking any recognition of such need or advantage, there would have been no reason to modify the tissue expander of Boyd with structure taken from the implant of Baker.

We disagree. As pointed out by the examiner (answer, page 4), the prior art provides the requisite motivation, suggestion, or teaching that would have led one of ordinary skill in the art to combine the teachings of Baker and Boyd. That is, given Baker's teachings (column 4, lines 56-59), one of ordinary skill in the art would have been led to reinforce the posterior portion of Boyd's device in order to prevent scar tissue "contractures" and thus maintain the intended profile of the device. Although the reason or motivation provided in the prior art to combine the references is not the same as that of the applicant, this does not in and of itself preclude a conclusion of obviousness. In re Kemps, 97 F.3d 1427, 1430, 40 USPQ2d 1309, 1311 (Fed. Cir. 1996); In re Dillon, 919 F.2d 688, 693, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990) (en banc).

The appellant alleges: "[I]t appears that [Baker's] reinforcement member 20 is a reinforcement member with respect to the gel material within the implant and thus it need not be

very stiff and has nothing to do with preventing folding over of the expandable envelope.” (Supplemental appeal brief, page 3.)

We find this argument unpersuasive. As we discussed at the outset, the present specification states that the prevention of the “folding over” problem is accomplished by making the base thicker or reinforced relative to the anterior portion. This structure is precisely what is described in Baker. Accordingly, the burden of proof was shifted to the applicant to provide objective evidence establishing that Baker’s reinforcement member would be incapable of performing the function recited in appealed claim 19.⁴ On this point, it is well settled that when a claimed product reasonably appears to be substantially the same as a product disclosed in the prior art, the burden of proof is on the applicant to prove that the prior art product does not inherently or necessarily possess the characteristics attributed to the claimed product. Cf. In re Schreiber, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997) (“[C]hoosing to define an element functionally, i.e., by what it does, carries with it a risk...[W]here the Patent Office [PTO] has reason to believe that a functional limitation asserted to

⁴ Baker teaches that the reinforcement member must be sufficiently rigid to equalize external forces exerted on the device and to maintain the intended profile of the device. (Column 4, lines 52-59.)

be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on."); accord In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990); In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977). Whether the rejection is based on inherency under 35 U.S.C. § 102 or on obviousness under 35 U.S.C. § 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the PTO's inability to manufacture products or to obtain and compare prior art products. In re Best, 562 F.2d at 1255, 195 USPQ at 433-34.

The appellant contends that "the much softer tapered portion 26 [of Baker's device] would [] lack the necessary rigidity to cause member 20 to act as a means for preventing the expandable element from folding over on itself during placement or implantation." (Supplemental appeal brief, page 3.) The appellant's contention, however, is based on conjecture, not evidence.

For these reasons, we affirm.

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Summary

In summary, we reverse the examiner's rejection under 35 U.S.C. § 112, ¶1, of appealed claim 22 as lacking written description. We affirm, however, the rejection under 35 U.S.C. § 103(a) of appealed claims 19, 20, and 22 as unpatentable over Boyd in view of Baker.

The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Terry J. Owens)	
Administrative Patent Judge)	
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